PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Takeshi SHIRAI et al. Group Art Unit: 2872

Application No.: 10/569,207 Examiner: A. AMARI

Filed: February 23, 2006 Docket No.: 127104

For: OPTICAL ELEMENT AND EXPOSURE APPARATUS

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the October 7, 2008 Election of Species Requirement, Applicants provisionally elect Species 7, directed to the seventh embodiment, with traverse. Applicants submit that at least claims 37-39 and 60-63 read on the elected species. Applicants note that claim 63 is added by the attached Preliminary Amendment.

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. *See* MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

> Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical

> features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. *See* MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.*

Page 3 of the Office Action states that the species lack the same or corresponding special technical features because Species 1-7 each recite mutually exclusive features or characteristics from each other. Applicants respectfully disagree,

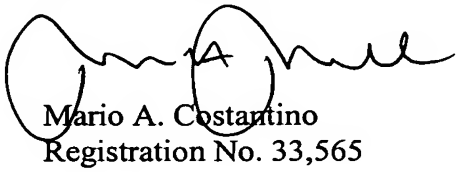
Applicants assert that independent claims 1, 37, 40 and 60 share common subject matter (i.e., An optical element/exposure apparatus to be used for an exposure apparatus configured to illuminate a mask with an exposure light beam for transferring a pattern on the mask onto a substrate through a projection optical system and to interpose a given liquid in a space between a surface of the substrate and the projection optical system) and, therefore, *a priori* unity of invention exists between all the claims. Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. *See* ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of the subject matter that is common to independent claims 1, 37, 40 and 60 is known in the prior art. Therefore,

Applicants respectfully submit that lack of unity of invention has not been established, and thus an Election of Species Requirement based on a lack of unity of invention is improper.

Thus, withdrawal of the Election of Species Requirement is respectfully requested.

Respectfully submitted,



Mario A. Costantino
Registration No. 33,565

Rodney H. Rothwell, Jr.
Registration No. 60,728

MAC:RHR/kcp

Date: November 7, 2008

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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